

REMARKS

The Final Office Action dated October 25, 2010, has been received and reviewed. Claims 1 through 26, 28 through 33, and 35 through 112 are currently pending in the application, of which claims 26, 28 through 33, and 35 through 39 are currently under examination. Claims 1 through 25, and 40 through 112 are cancelled, without prejudice, as being drawn to a non-elected invention. Claims 26, 28 through 33, and 35 through 39 stand rejected. Applicants propose to amend claim 26 and respectfully request reconsideration of the application in view of the remarks presented herein.

Claim 26 is amended herein to correct minor typographical errors.

Related Applications

The Examiner's attention is respectfully drawn to Applicants' insertion of a CROSS-REFERENCE TO RELATED APPLICATIONS, wherein one related application has been newly identified.

Information Disclosure Statement

Please note that an Information Disclosure Statement was filed herein on December 2, 2003, and that no copy of the PTO Form 1449 was returned with the outstanding Office Action. It has been verified that the Information Disclosure Statement of December 2, 2003 has been filed and has been entered into the record as confirmed in the Image File Wrapper on PAIR as of November 3, 2010. It is respectfully requested that an initialed copy of the PTO Form 1449 evidencing consideration of the cited references be returned to the undersigned attorney.

35 U.S.C. § 112 Claim Rejections

Claim 26 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection, as hereinafter set forth.

The Examiner has objected to claim 26 as reciting “*solely* responsive to the at least one patron placing the at least one first wager, providing the at least one patron with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race by selecting the at least one wager option on the display element with the input device.” The Examiner states that the specification does not support the limitation of “solely” responsive to the at least one patron placing the at least first wager. Office Action, p. 2. **There is no *in haec verba* requirement**, and newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. MPEP §2163. As clearly indicated in FIG. 24 of the as-filed specification, there are no intervening steps between “Accept Bet” 101 and “Accept Add-A-Bet” 103. Because there are no intermediate, intervening steps, it is both implicit and inherent in FIG. 24 that the Add a Bet wager option is provided to the patron solely responsive to the patron accepting (i.e. placing) the first bet. In addition, paragraph [0068] recites that “patrons may be *automatically* presented with additional logical bets to augment previous bets as recorded in the wagering system or presented with another wagering proposition.” Again, it is both implicit and inherent in the specification that the patron is provided with at least one wager option in response to the player placing at least one first wager, and, therefore, it is both implicit and inherent that the patron is provided with the at least one wager option solely in response to the patron placing the at least one first wager.

Because claim 26 is both implicitly and inherently described by the as-filed specification, the subject matter of claim 26 is adequately described in the specification in such a way as to reasonably convey to one of ordinary skill in the art, at the time the application was filed, that the inventors had possession of the claimed invention. Accordingly, Applicants request the Examiner withdraw the rejection to claim 26 under 35 U.S.C. § 112, 1st paragraph.

35 U.S.C. § 102(e) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent Publication No. 2003/0125822 to LaNeve

Claims 26, 28 through 33, and 35 through 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by LaNeve (U.S. Patent Publication No. 2003/0125822) hereinafter referred to as “LaNeve.” Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Unless a single prior art reference describes “all of the limitations claimed” and “all of the limitations [are] arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN Inc. v. VeriSign Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added). A single prior art reference must “clearly and unequivocally” describe the claimed invention “without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *Id.* (citing *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972)).

LaNeve does not anticipate claims 26 and 28 through 32 because LaNeve does not expressly or inherently describe each and every element of independent claim 26. Specifically, LaNeve does not describe “***solely responsive to*** the at least one patron placing the at least one first wager, providing the at least one patron with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race by selecting the at least one wager option on the display element with the input device,” as recited in claim 26. It appears the Examiner is disregarding the responsive to language of claim 26. In LaNeve, *nothing happens* responsive to the patron placing a wager. See LaNeve at FIG. 6 (illustrating that the wagering system of LaNeve stops after a first bet has been placed). If a user in LaNeve wishes to place an additional wager on the race after submitting the first wager, the user will have to (1) restart the wagering system and then reenter the desired race, (2) select the runner to view the probable payout information for the runner, (3) select the desired probable payout value where it is upon the user to make sure that the same bet as the previous bet is not chosen, and then (4) submit the second bet. These four intermediate steps clearly do not expressly or inherently describe solely responsive to the at least one patron placing the at least one first wager, providing the at least one patron with at least one wager option. Accordingly, the at least one wager option

described in LaNeve is not *solely responsive to* the at least one patron placing the at least one first wager, but rather, requires the user to independently restart the wagering system and pick the same race parameters. Additionally, the wager option presented to the user in LaNeve will only include the at least one runner if the user chooses the same runner, not solely responsive to the user placing the first wager with the at least one runner. As such, LaNeve does not expressly or inherently describe solely responsive to the at least one patron placing the at least one first wager, providing the at least one patron with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race by selecting the at least one wager option on the display element with the input device.

Since LaNeve does not expressly or inherently describe each and every element of claim 26, Applicant respectfully requests withdrawal of the anticipation rejection of this claim.

Regarding claims 28 through 32, these claims depend from claim 26 which is allowable. Therefore, at least by virtue of their dependence from an allowable claim, claims 28 through 32 are allowable.

LaNeve does not anticipate claims 33 and 35 through 39 because LaNeve does not expressly or inherently describe each and every element of independent claim 33. Specifically, LaNeve does not disclose “*automatically responsive to* the at least one patron placing the at least one first wager with the input device, the at least one patron is presented with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race displayed on the display element by selecting the at least one wager option with the input device,” as recited in claim 33. Rather, as previously discussed regarding claim 26, it appears the Examiner is disregarding the responsive to language of claim 33. In LaNeve, *nothing happens* responsive to the patron placing a wager. See LaNeve at FIG. 6 (illustrating that the wagering system of LaNeve stops after a first bet has been placed). If a user in LaNeve wishes to place an additional wager on the race after submitting the first wager, the user will have to (1) restart the wagering system and then reenter the desired race, (2) select the runner to view the probable payout information for the runner, (3) select the desired probable payout value where it is upon the user to make sure that the same bet as the previous bet is not chosen, and then (4) submit the second bet. These four intermediate steps clearly do not expressly or inherently describe solely

responsive to the at least one patron placing the at least one first wager, providing the at least one patron with at least one wager option. Accordingly, the at least one wager option described in LaNeve is not *automatically responsive to* the at least one patron placing the at least one first wager, but rather, requires the user to independently restart the wagering system and pick the same race parameters. Additionally, the wager option presented to the user in LaNeve will only include the at least one runner if the user chooses the same runner, not automatically responsive to the user placing the first wager with the at least one runner. As such, LaNeve does not expressly or inherently describe automatically responsive to the at least one patron placing the at least one first wager with the input device, the at least one patron is presented with at least one wager option including the at least one runner and an opportunity to place at least one second wager on the race displayed on the display element by selecting the at least one wager option with the input device.

Since LaNeve does not expressly or inherently describe each and every element of claim 33, Applicant respectfully requests withdrawal of the anticipation rejection of this claim.

Regarding claims 35 through 39, these claims depend from claim 33 which is allowable. Therefore, at least by virtue of their dependence from an allowable claim, claims 34 through 39 are allowable

ENTRY OF AMENDMENTS

The proposed amendments to claim 26 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 26, 28 through 33, and 35 through 39 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



Belinda A. Suwe
Registration No. 61,239
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: April 22, 2011
BAS/dlm:lhs